APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,001	03/04/2002	Philip T. Mellinger	020375-008900US	6755

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EXAMINER
BUI, THACH H

ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 10/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on <u>01 March 2002</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-47</u> is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-47</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)   4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> .   6) ☐ Other: .

DETAILED ACTION

Information Disclosure Statement

1.   Applicant's prior art citation filed July 09, 2002 has been received, considered

and placed of record.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the
> conditions and requirements of this title.

Claims 1-47 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter, particularly, an abstract idea.

The Examiner notes that the disclosed invention is within the technological arts.

The claimed invention is also noted not to be a computer program, data structure, a

natural phenomenon, and a non-descriptive material per se. The claimed invention

does not include a series of steps to be performed by a computer. The claimed

invention also is not a product for performing a process, not it is a specific machine or

manufacture. The claimed invention is not a specific tangible machine or process for

facilitating a business transaction. Claims 1-47 do not appear to correspond to a

specific machine or manufacture disclosed within the instant specification and thus

encompasses any product of the class configured in any manner to perform the

underlying process. The claimed invention of claims 1-47 also does not include a post-

computer process activity or a pre-computer process activity. Thus, no physical

transformation is performed, no practical application in the technological art is found.

Consequently, claims 1-8 are analyzed based upon the underlying process, and are

thus rejected as being directed to a non-statutory process.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.   Regarding claims 9-11, 22-24, and 40-42 the phrase "about" renders the claim

indefinite because it is unclear whether the limitations following the phrase are part of

the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-47, as best understood, are rejected under 35 U.S.C. 103(a) as being

unpatentable over Joao et al. (U.S. Patent No. 5,903,830)

As per claim 1, Joao et al. teach a computer system having methods of

monitoring financial transactions comprising a means for receiving financial transaction

information. The financial transaction information includes transaction records (i.e.

spending habits, data of transaction, time of transaction, geographical area of spending

and etc.) for a plurality of financial transactions that each has at least one associated

account identifiers (column 8, lines 23-33) (column 16, lines 4-35). Joao et al. do not

explicitly mention a means for periodically receiving a target account identifier of a

suspect account, and a means for comparing the target account identifier with the

transaction information to determine if the target account identifier matches any of the

account identifiers of the transaction information. However, Joao et al. teaches a

computer system having a processor processes accounts for any of the various banks

and/or financial institutions which issue and/or manage credit cards, charge cards, debit

cards, and/or currency or "smart card" and/or process or manage these accounts

(column 4, lines 23-31). The central processor also process and/or searching the

information and/or data pertinent to the transaction in conjunction with the card account

information in order to determine if the card has been lost, stolen and/or cancelled

(column 5, lines 40-50). Further, Joao et al. teach a system includes a means for

generating an alert (column 6, lines 4-17). Therefore, it would have been obvious to

one having ordinary skill in the art at the time the invention was made to realize that the

system, as taught by Joao et al., is capable of having means for identifying the target

account identifier is a suspect account and comparing the target account identifier with

the transaction information to determine if the target account identifier matches any of

the account identifiers of the transaction information. Furthermore, it would have been

obvious to one skilled artisan to modify the current system to generate an alert having at

least a portion of the transaction record that has an account identifier matching the

target account identifier.

As per claims 2 and 4, Joao et al. do not explicitly mention an alert transmitted electronically to a provider of the target account identifier. However, Joao et al. teaches a computer system having a processor processes accounts for any of the various banks and/or financial institutions which issue and/or manage credit cards, charge cards, debit cards, and/or currency or "smart card" and/or process or manage these accounts (column 4, lines 23-31); therefore, it would have been obvious to one skilled artisan in the art to automatically generate an alert transmitted electronically to a provider and/or to a designee of a provider of the target account identifier when it appears to be unordinary.

As per claims 3 and 5, Joao et al. teach an alert transmitted electronically to the owner of the suspect account (column 6, lines 4-17) (column 8, lines 60-65). Furthermore, it would have been obvious to generate an alert to any means relating to the account identifiers i.e. a compiler of marketing information and etc.

As per claim 6, it contains features addressed in claim 1, and therefore, is rejected under the same rationale.

As per claim 7, it contains features addressed in claim 1, and therefore, is rejected under the same rationale.

As per claim 8, it contains features addressed in claim 1, and therefore, is rejected under the same rationale.

As per claims 9-11, Joao et al. teach a computer system that is capable to compare and to transmit information (column 13, line 49- column 14, line 51).

As per claim 12 Joao et al. teach an alert (an electronic textual message) about the content of the electronic data (column 6, lines 4-17).

As per claim 13, it contains features addressed in the above claims, and therefore, is rejected under the same rationale. In addition, applicant recited a processing server. Joao et al. teach a server (450) coupled with the system to receive transaction information and it also generates an alert that the platform server has identified a transaction record having a target account identifier.

As per claim 14, Joao et al. do not explicitly mention the list comprising an electronic file from a government agency. However, Joao et al. disclose a computer system having a processor processes accounts for any of the various banks and/or financial institutions which issue and/or manage credit cards, charge cards, debit cards, and/or currency or "smart card" and/or process or manage these accounts (column 4, lines 23-31). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide services to a government agency as it provides services to various banks and/or financial institutions.

As per claims 15 and 16, Joao et al. do not mention explicitly the processing server processes the list daily (for example requested and received the list). However, Joao et al. teach a system that is capable to have a real-time notification. Therefore, it would have been obvious to one skilled artisan in the art to realize that the system, as taught by Joao et al. comprises a processing server processes daily.

As per claims 17 and 18, Joao et al. do not mention a means for transmitting from the processing server a list available message to at least one platform server

indicating that the processing server has received a list, in response to which the at

least one platform server transmits a request to the processing server to send the list.

However, Joao et al. disclose a means for transferring a message from one location to

another. In addition, Joao et al. also includes a means to await, receive and response

to the message (see Figure 6). Therefore, it would have been obvious to one skilled

artisan in the art to modify the system, as taught by Joao et al. to have a means for

transmitting from the processing server a list available message to at least one platform

server indicating that the processing server has received a list, in response to which the

at least one platform server transmits a request to the processing server to send the list.

As per claims 19-21, they contain features addressed in claims 3 and 5, and

therefore, are rejected under the same rationale.

As per claims 22-24, Joao et al. do not explicitly mention the duration (about 15

or 1 minute) of the notification is being transmitted from the time that the alert is

received. However, it would have been obvious to one skilled artisan in the art to

understand that the duration of the notification can be transmitted depending on the set

system. The system can be set to send a notification right after the alert was indicated

or it can wait for a finite period of time.

As per claim 25, it contains features addressed in claim 1, and therefore, is

rejected under the same rationale.

As per claim 26, Joao et al. do not explicitly mention the notification includes the

account identifier, the data, the time and the address where the account identifier was

used. However, Joao et al. teach a computer system that is capable to monitor the

number of transactions of which are unauthorized by the cardholder (column 8, lines 24-

27), and an alert means to the authorized card holder. Therefore, it would have been

obvious to one skilled artisan in the art to modify the current system, as taught by Joao

et al. to have a notification including the account identifier, the data, the time and the

address where the account identifier was used.

As per claim 27, Joao et al. teach a system having a means for processing the

alert at the processing server (450) by combining transaction data from the alert with

stored transaction data in the database (3H) relating to the target account identifier, and

wherein the notification is based on the alert and the stored transaction data.

As per claim 28, it contains features addressed in claims 1 and 13, and therefore,

is rejected under the same rationale.

As per claim 29, Joao et al. do not mention explicitly mention a means for

requesting the list from the processing server. However, Joao et al. disclose a

database (3H), and database comprises multiple lists so that the processor server can

retrieve the information as needed. Therefore, it would have been obvious to one

skilled artisan in the art to understand that the system, as taught by Joao et al. is

capable of requesting the list from the processing server.

As per claim 30, it contains features addressed in claim 12, and therefore, is

rejected under the same rationale.

As per claims 31-34, they contain features addressed in the above claims, and

therefore, are rejected under the same rationale.

As per claims 35 and 36, Joao et al. do not mention a means for transmitting from the processing server a list available message to at least one platform server indicating that the processing server has received a list, in response to which the at least one platform server transmits a request to the processing server to send the list. However, Joao et al. disclose a means for transferring a message from one location to another. In addition, Joao et al. also includes a means to await, receive and response to the message (see Figure 6). Therefore, it would have been obvious to one skilled artisan in the art to modify the system, as taught by Joao et al. to have a means for transmitting from the processing server a list available message to at least one platform server indicating that the processing server has received a list, in response to which the at least one platform server transmits a request to the processing server to send the list.

As per claims 37-39, 43-47, they contain features addressed in the above claims, and therefore, are rejected under the same rationale.

As per claims 40-42, the claims contain features addressed in claims 22-24, and therefore, are rejected under the same rationale.

Conclusion

5.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kennedy, Joao et al., and Person are cited of general interest.
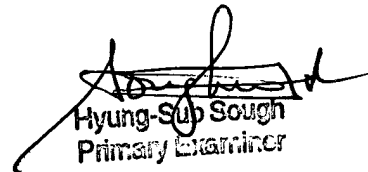
6.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thach H Bui whose telephone number is 703-305-0063. The examiner can normally be reached on Monday-Friday, 7:30-4 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hyung S. Sough, can be reached on 703-308-0505. The fax phone

numbers for the organization where this application or proceeding is assigned are 703-

305-7687 for regular communications and 703-305-7687 for After Final

communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-308-

1113.

T.B.
October 18, 2002

Hyung-Sub Sough
Primary Examiner